


1638

<b>FEE TRANSMITTAL for FY 2001 (Small Entity)</b> 		<i>Complete if Known</i>	
		Application Number	09/439,534
		Filing Date	12 November 1999
		First Named Inventor	Simon MOLLER et al.
		Examiner Name	A. Mehta
Group Art Unit		1638	
Total Amount of Payment		(\$55.00)	
Attorney Docket Number		2312-103	

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**METHOD OF PAYMENT (check one)**

1. ☒ The Commissioner is hereby authorized to charge additional fees and credit any overpayment to Deposit Account Number 02-2135 in the name of Rothwell, Figg, Ernst & Manbeck
- ☒ Charge any Additional Fee Required Under 37 CFR 1.16 and 1.17
- ☒ Applicant claims small entity status.
2. ☒ Payment Enclosed:  
☒ Check  
☐ Credit Card

**FEE CALCULATION (continued)**

**3. ADDITIONAL FEES**

Fee Code	Fee Paid	Fee Description	Fee Paid
205	65	Surcharge - late filing fee or oath	[ ]
227	25	Surcharge - late provisional filing fee or cover sheet	[ ]
139	130	Non-English specification	[ ]
147	2,520	For filing a request for reexamination	[ ]
112	920	Requesting publication of SIR prior to Examiner action	[ ]
113	1,840*	Requesting publication of SIR after Examiner action	[ ]
215	55	Extension for reply within first month	[\$55.]
216	195	Extension for reply within second month	[ ]
217	445	Extension for reply within third month	[ ]
218	695	Extension for reply within fourth month	[ ]
228	945	Extension for reply within fifth month	[ ]
219	155	Notice of Appeal	[ ]
220	155	Filing a brief in support of an appeal	[ ]
221	135	Request for Oral Hearing	[ ]
138	1,510	Petition to institute a public use proceeding	[ ]
240	55	Petition to revive -unavoidable	[ ]
241	640	Petition to revive - unintentional	[ ]
242	620	Utility issue fee (or reissue)	[ ]
243	220	Design issue fee	[ ]
244	300	Plant issue fee	[ ]
122	130	Petitions to the Commissioner	[ ]
123	50	Processing fee under 37 CFR 1.17(q)	[ ]
126	180	Submission of Information Disclosure Statement	[ ]
581	40	Recording each patent assignment per property (times number of properties)	[ ]
246	355	Filing a submission after final rejection (37 CFR 1.129(a))	[ ]
249	355	For each additional invention to be examined (37 CFR 1.129(b))	[ ]
279	355	Request for Continued Examination (RCE)	[ ]
169	900	Request for expedited examination of a design application	[ ]
195	300	Publication fee for early, voluntary, or normal publication	[ ]
196	300	Publication fee for republication	[ ]
089	200	Filing an application for patent term adjustment	[ ]
090	400	Request for reinstatement of term reduced	[ ]
Other fee (specify)			[ ]

**FEE CALCULATION**

**1. FILING FEE**

Fee Code	Fee \$	Fee Description	Fee Paid
201	355	Utility filing fee	[ ]
206	160	Design Filing Fee	[ ]
207	245	Plant Filing Fee	[ ]
208	355	Reissue Filing Fee	[ ]
214	75	Provisional Filing Fee	[ ]

**SUBTOTAL \$**

**2. CLAIMS**

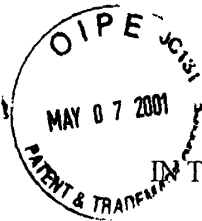
	Extra Claims	Fee	Fee Paid
Total Claims [ ] - 20** = [ ] x		\$ 9 =	[ ]
Independent Claims [ ] - 3** = [ ] x		40 =	[ ]
Multiple Dependent Claims +		135 =	[ ]

\*\*or number previously paid, if greater;

**SUBTOTAL \$**

\* Reduced by Basic Filing Fee Paid      **SUBTOTAL \$55.00**

SUBMITTED BY		Complete (if applicable)	
NAME AND REG. NUMBER	Stephen A. Saxe, Ph.D., Reg. No. 38,609		
SIGNATURE	DATE	DEPOSIT ACCOUNT USER ID	



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#8  
AP  
5/10/01

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In re Application of

Simon MOLLER et al.

Serial No. 09/439,534

Examiner: A. Mehta

Filed: 12 November 1999

Group Art Unit: 1638

For: INDUCIBLE SITE-SPECIFIC  
RECOMBINATION FOR THE  
ACTIVATION AND REMOVAL  
OF TRANSGENES IN  
TRANSGENIC PLANTS

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents  
Washington, DC 20231

Dear Sir:

In response to the Office Action in the form of a restriction requirement mailed 23 March 2001, Applicants elect to have the claims of Group V (claims 39-47, 59, 60 and 72) examined. This election is made with traverse.

REMARKS

Applicants do not disagree with the division of the claims of Group VII from the remainder of the claims, but Applicants urge that the claims of Groups I-VI should be considered to be a single invention and it is requested that all of the claims of Groups I-VI (claims 1-62 and 68-73) be examined together.

The claims of Groups I and II are especially closely related to each other, the claims of Groups III and IV are especially closely related to each other, and the claims of Groups V and VI are especially closely related to each other.

The claims of both Groups I and II are illustrated by Figure 1. Looking at the language of claim 1 (part of Group I), the first gene is represented by GVG of Figure 1, the second gene is represented by CRE and is inducible because of the 6xUAS element, the constitutive promoter is

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35S, the third gene is LUC, and the two recombination sites are the Lox sites. In terms of claim 11 (Group II), the inducible promoter is 6xUAS, the first gene is CRE, the constitutive promoter is 35S, the two recombination sites are the Lox sites, and the second gene is LUC. These two sets of claims can be considered subsets of each other since each does not require all the elements of the other.

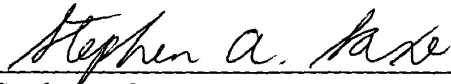
Similarly the claims of Groups III and IV are very closely related to each other and the claims of both groups are illustrated by Figure 3. Examining the language of claim 20 (Group III), the first gene is GVG, the second gene is CRE, the constitutive promoter is 35S, the third gene is LUC and the recombination sites are the Lox sites. Claim 30 (Group IV) is represented by Figure 3 in that the inducible promoter is 6xUAS, the first gene is CRE, the constitutive promoter is 35S, the recombination sites are the Lox sites, and the second gene is LUC. Again the two sets of claims can be considered subsets of each other.

The claims of Groups V and VI are similarly related and are illustrated by Figure 4. Considering claim 39 (Group V), the gene encoding a transcription factor is GVG, the marker gene is KAN, the inducible gene encoding a recombinase is CRE, and the two recombinase sites are the two Lox sites. For claim 48 (Group VI), the marker gene is KAN, the inducible gene encoding a recombinase is CRE, and the recombination sites are the Lox sites. In fact, the only difference between claims 39 and 48 is that claim 39 includes a requirement for a gene encoding a transcription factor. Claim 39 could in fact be drafted as a claim dependent from claim 48, the claim being "The vector of claim 48 further comprising a gene encoding a transcription factor wherein said recombination sites flank said gene encoding a transcription factor, said marker gene and said inducible gene." This illustrates the very close connection between independent claim 39 (Group V) and independent claim 48 (Group VI).

In addition to the closeness of each pair of groups (I and II, III and IV, and V and VI), it is further urged that each group is related to the other groups. All of the claims involve as part of the inventive concept the use of promoters and recombinases to cut a portion of a vector to effect a desirable result, e.g., expression of gene which was not expressed prior to inducing the system or the deletion of a gene which is no longer desired. The concept of using promoters and recombinases is a constant throughout all of the claims.

In view of the above arguments, it is urged that minimally the claims of Group VI should be examined with the claims of Group V and it is further urged that the claims of Groups I-IV as well as VI should be examined together with the claims of Group V.

Respectfully submitted,

A handwritten signature in cursive script, reading "Stephen A. Saxe", is written over a horizontal line.

Stephen A. Saxe

Registration No. 38,609

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Dated: 7 May 2001

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